

### **REMARKS**

Applicant appreciates the Examiner's thorough consideration provided with respect to the present application. Claims 1-4, 8, 11-13, 16-18, 23 and 25-29 are currently pending in the instant application. Claims 1, 23 and 25 are independent. Claims 1 and 23 have been amended and claims 25-29 have been added. Applicant submits that the subject matter of claims 25-29 is fully supported by the original written description, including but not limited to the original claims and the corresponding description in the specification at pages 14-23 and 32. Reconsideration of the present application is earnestly solicited.

### **Double Patenting**

Claims 1 and 23 have been cited as being alleged duplicates of one another. This rejection is respectfully traversed.

The Examiner is respectfully requested to review claims 1 and 23 again, since these claims clearly contain unique combinations of limitations that are not provided in both of these claims, e.g., claim 1 is directed at suitable combinations of the listed special image processes and claim 23 is directed at unsuitable combinations of the listed special image processes.

**Claim Rejections Under 35 U.S.C. § 103**

Claims 1, 3, 8, 11, 13, 16, 18 and 23 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kubo et al. (U.S. Patent No. 5,828,461) in view of Anderson et al. (U.S. Patent No. 5,049,929), and further in view of Hayes (U.S. Patent No. 6,006,279). Claims 2, 4, 12 and 17 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kubo in view of Anderson et al., and further in view of Hayes, and further in view of Nealon (U.S. Patent No. 5,023,635). These rejections are respectfully traversed.

Applicant submits that the prior art of record fails to teach or suggest each and every element of the unique combination of elements of the claimed invention. Further, Applicant submits that the alleged combination(s) of the prior art of record would not have been obvious to one of ordinary skill in the art. Specifically, Applicant submits that if each of the references relied upon by the Examiner are considered in their entirety, one of ordinary skill in the art would not have been motivated to modify the Kubo patent as alleged by the Examiner. Accordingly, these rejections should be withdrawn.

The Examiner has repeatedly relied upon examples of allegedly mutually exclusive special image processes from the prior art of record as practical examples of separate special imaging processes that may be combined to read

on the claimed invention. However, Applicant respectfully submits that this interpretation is unreasonably broad in light of the limitations of claims 1 and 23.

With respect to claim 1, the prior art of record fails to teach or suggest the combination of elements of the claimed invention, including the limitation(s) of "means for carrying out a special image processing on the image data read by the image reading device, the special image processing being specially designated by an operator request; and means for instructing the special image processing to be carried out by said special image processing means, wherein the special image processing is canceled if *at least two separate special image processes are instructed by said means for instructing and said at least two separate special image processes are combined in a combination other than a predetermined combination of at least two separate special image processes that have been linked together in advance as suitable combinations of separate special image processes*, and the special image processing is not canceled if *at least two separate special image processes are instructed by said means for instructing and said at least two separate special image processes are combined, wherein the predetermined combination is a combination of at least two separate special image processes set in advance*,

*wherein the predetermined combination is a combination of at least two separate special image processes set in advance and at least one of said separate special image processes is selected from the group consisting of LF Lens Correction, Hypersharpness, Hypertone, Facial Expression Improvement, RP Finish, Monotone Finish, Brightness Enhancement, Fine Finish, Portrait Finish, Red Eye Correction, Cross Filter, Mirror, Negative/Positive Inverting, Color Pencil Touch, Poster Type, Posted Bill, Background Exchange and Layer Transparent processes.” (emphasis added)*

With respect to claim 23, the prior art of record fails to teach or suggest the combination of elements of the claimed invention, including the limitation(s) of “means for instructing the special image processing to be carried out by said special image processing means, wherein unsuitable combinations of image processings are prohibited from being executed on the image by said special image processing means and suitable combinations of image processings are permitted to be executed on the image by said special image processing means, *said unsuitable combinations of image processings including a predetermined combination of at least two separate special image processes selected from the group consisting of LF Lens Correction, Hypersharpness, Hypertone, Facial Expression Improvement, RP Finish,*

*Monotone Finish, Brightness Enhancement, Fine Finish, Portrait Finish, Red Eye Correction, Cross Filter, Mirror, Negative/Positive Inverting, Color Pencil Touch, Poster Type, Posted Bill, Background Exchange and Layer Transparent processes, wherein said predetermined combination includes an erroneous combination of special image processes.”* (emphasis added) Accordingly, this rejection should be withdrawn.

The Examiner has admitted that Kubo fails to teach or suggest each and every limitation of claims 1 and 23. In order to overcome this deficiency, the Examiner has relied upon the alleged teachings of Anderson et al. Applicant submits that the Anderson et al. reference deals with image reproduction in a non-analogous xerographic reproduction machine. Although the Examiner has indicated that this reference would be analogous to Kubo et al. as it relates to complex reprographic systems with many user selectable features (see col. 2, lines 8-10) and the organization of mutually exclusive image processes, Applicant submits that Kubo and/or Anderson et al. are not related to the processing of both necessary image processes and special image processes as described by claims 1 and 23. Specifically, since Anderson et al. is directed at a xerographic reproduction machine, it does not appear that the mutually exclusive image processes discussed by Kubo and/or Anderson et al. are

*special* image processes. Accordingly, Anderson et al. clearly does not include the management of any mutually exclusive special image processes with either suitable or unsuitable combinations of the special image processes listed in claims 1 and 23.

With respect to additional claims 25-29, the Examiner has relied upon the Anderson et al. reference to provided a teaching that the Kubo et al. reference would have been modified to include the predetermined control of separate special image processes, particularly mutually exclusive processes. Specifically, the Examiner has indicated that the Anderson et al. reference teaches a system that has “an additional benefit in that the automatic deselection of a feature would eliminate the need for the operator to manually deselect the feature, thereby increasing an operator’s efficiency.” (See col. 2, lines 47-52) However, it does not appear that any of the references relate to the automatic processing of *necessary* image processes and the *selective special* image processing based on an operator request of separate, suitable and unsuitable *special* image processes.

The Examiner acknowledges that the Anderson et al. reference does not address the management of suitable and unsuitable special image processes, and attempts to cure this deficiency with the use of the Hayes reference.

However, Applicant submits that one of ordinary skill in the art would not attempt to first modify the Kubo et al. device in view of Anderson et al., and then further modify the resulting combination in view of Hayes. Specifically, the motivations to alter the Kubo device as alleged by the Examiner appear to come from Applicant's own teachings and are not taught or suggested by the references themselves. Accordingly, this rejection appears to be based upon an improper hindsight reconstruction of the prior art of record based solely on Applicant's own teachings. For example, none of the references relied upon by the Examiner deal with *automatic necessary image processing and selective special image processing* of predetermined suitable and/or unsuitable special image processes. However, the Examiner has improperly suggested that the resulting combination of these references would result in the unique combination of features of claims 1 and 23. Applicant submits that the motivation to alter these references comes from Applicant's own disclosure. Specifically, none of these references deal with solving the problems identified heretofore only by Applicant.

Applicant submits that the Examiner is misinterpreting processes such as an image's size, color tone and white margin as separate special image processes. These processes are not special image processes or special

processes as suggested by the Examiner. Applicant submits that one of ordinary skill in the art would not consider the Kubo processes as "special" image processes. Applicant submits that Applicant's own disclosure does not treat these processes as separate special image processes. Further, claims 1 and 23 do not permit the interpretation advanced by the Examiner with respect to variations of image size, color tone and white margin. There is no mention of any special image processing in the Kubo reference. Accordingly, this rejection is improper and should be withdrawn.

In the claimed invention, it is possible to combine special image processings together, e.g, the operator can set any suitable combination to be processed. However, the operator may also set any predetermined combination of processes as being incompatible for each user and may even combine three or more processes that may be processed with the claimed invention, e.g., as described on pages 23 to page 24 (line 9) of the present application.

For example, it is possible to combine processes such as "Hypersharpness" with "Hypertone" and "Hypersharpness" with "Portrait Finish" in the claimed invention. Therefore, the combination of Hypersharpness with Hypertone and/or Hypertone with Portrait Finish may be selected and processed by a user. Alternatively, Hypersharpness may be



cancelled when the combination of Hypersharpness with Portrait Finish is erroneously selected by a user. Applicant submits that the subject matter of claims 1 and 23 is further described in the specification, including the special imaging processes generally described at pages 20 (Table 1), page 29 (lines 3-9), page 30 (lines 5-27) and page 31 (lines 1-21) of the present application; and the necessary image processes described on page 18. None of the prior art references teach or suggest this advantageous feature of the claimed invention.

In accordance with the above discussion of the patents relied upon by the Examiner, Applicant respectfully submits that these documents, either in combination together or standing alone, fail to teach or suggest the invention as is set forth by the claims of the instant application. The Examiner is requested to contact the undersigned via telephone in the Washington, DC area to conduct the requested personal interview if this rejection is maintained in any form upon entry and consideration of this Amendment.

Accordingly, reconsideration and withdrawal of the claim rejections is respectfully requested. As to the dependent claims, Applicant respectfully submits that these claims are allowable due to their dependence upon an allowable independent claim, as well as for additional limitations provided by these claims.

### **CONCLUSION**

Since the remaining references cited by the Examiner have not been utilized to reject the claims, but merely to show the state-of- the-art, no further comments are deemed necessary with respect thereto.

All the stated grounds of rejection have been properly traversed and/or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently pending rejections and that they be withdrawn.

It is believed that a full and complete response has been made to the Office Action, and that as such, the Examiner is respectfully requested to send the application to Issue.

In the event there are any matters remaining in this application, the Examiner is invited to contact Matthew T. Shanley, Registration No. 47,074 at (703) 205-8000 in the Washington, D.C. area.

Docket No. 1982-0127P

Appl. No.: 09/333,963

Art Unit: 2623

Amendment dated February 22, 2005

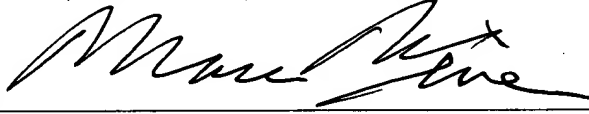
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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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